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09/867,923	05/30/2001	Matthew S. Meyerson	FIS920010070US1	7553

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EXAMINER	
ROCHE, TRENTON J	

ART UNIT	PAPER NUMBER
2124	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/867,923	MEYERSON, MATTHEW S.	
	Examiner	Art Unit	
	Trent J Roche	2124	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 October 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is responsive to communications filed 12 October 2004.

2. Per applicant's request, amended claim 19 has been entered. Claims 1-26 are now pending.

3. Claims 1-26 have been examined.

Drawings

4. The drawings were received on 12 October 2004. These drawings are acceptable.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8, 12-13, 20, and 22-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Cole et al. (U.S. Patent No. 5,752,042), hereafter "Cole".

As to claim 1, Cole teaches:

downloading software update information through a network to the computer (col. 3, lines 35-40, "client downloads update manager, ...");

determining if a software update is available from the software update information (col. 4, lines 2-8, "table list code updates available");

downloading a criticality check program through the network to the computer (col. 3 lines 40-44, "client downloads recognizer program from server"; Fig. 3a);

executing the criticality check program on the computer (col. 3, lines 40-44, "...and executes it"; Fig. 3a);

evaluating the criticality of the software update from an output of the criticality check program and the software update information (col. 3, line 52 - col. 6, line 30; col. 3, lines 52- 54, "sends information obtained by recognizer program"; col. 6, lines 1-4 "determines the level of criticality");

accessing stored user preference information (col. 3, lines 42-52, "obtains basic system information about the client"; Abstract, "user selects from a list and sends"); and

determining if the software update should be automatically downloaded and installed from the user preference information and the evaluated criticality of the software update (col. 5, line 55 - col. 6, line 35, "results include yes/no answers whether code update is appropriate for client", "assign critical level for each code update based on the need of the client for the update"; Abstract, "in response to user selection, server sends code update addresses").

As to claim 2, Cole further teaches the software update information includes a criticality rating (col. 5, line 55 - col. 6, line 7, "assign a critical level to each code update", "server determines level of criticality of code updates for display at client").

As to claim 3, Cole further teaches wherein the step of executing the criticality check program on the computer includes determining the configuration of the computer (col.3, lines 40-50, a recognizer program obtains basic system information about client") and the step of evaluating the

criticality of the software update includes adjusting the criticality rating from the software update information dependent upon the configuration of the computer to produce the evaluated criticality of the software update (col. 3, lines 60-62, "assign a critical level based on the need of the client").

As to claim 4, Cole further discloses wherein the user preference information includes a user criticality threshold and the step of determining if the software update should be automatically downloaded and installed includes comparing the user criticality threshold and the evaluated criticality of the software update (col. 5, lines 60-65, "The recognizer... in client"; col. 6, lines 1-20, "minimum number of code updates").

As to claim 5, Cole further teaches wherein the software update information includes a location for downloading the criticality check program (col. 3, lines 28-42, "addressing information for the recognizer program").

As to claim 6, Cole further teaches wherein the step of downloading the criticality check program includes downloading the criticality check program from the criticality check program location (col. 3, lines 28-44, "furnishing addressing information", "downloads recognizer program from server").

As to claim 7, Cole further teaches wherein the software update information includes a location for downloading the software update (col. 6, lines 26-30, "server sends FTP addressing information for the code updates").

As to claim 8, Cole further discloses downloading the software update from the software update location; and automatically installing the software update (col. 6, lines 26-50, "Using FTP addressing, client downloads code updates", "client installs code updates").

As to claim 12, Cole further discloses the step of producing a notification if it is determined from the user preference information and the evaluated criticality of the software update that the software update should not be automatically downloaded and installed (col. 4, lines 53-58, "be noted... which of the code updates that are consistent"; col. 3, lines 56-67 & col. 6, lines 1-58).

As to claim 13, Cole further discloses the step of determining from the software update information whether to skip the steps of downloading and executing the criticality check program and evaluating the criticality of the software update (col. 4, lines 40-45, "no recognizer program is fetched"), and wherein the step of determining if the software update should be automatically downloaded and installed comprises comparing a user criticality threshold included in the user preference information with a criticality rating included in the software update information. (This claim is also rejected under the same rationale as claims 3 and 4).

As to claims 22, 23, and 24, rejection of claim 1 is incorporated and further claims 22, 23, and 24 recite limitations as recited in claim 1, therefore, claim 22, 23, 24 are rejected under the same rationale as claim 1.

As to claims 20, 25, and 26, rejection of claims 1, 2, 4, 8, 12, and 13 are incorporated and further claims 20, 25, and 26 ,recite limitations as recited in claims 1, 2, 4, 8, 12, and 13, therefore, claims 20, 25, and 26 are rejected under the same rationale as claims 1, 2, 4, 8, 12, and 13.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 14-16, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole.

As to claim 14, it would appear that Cole implies downloading software update information comprising periodically automatically downloading software update information through the network to the computer as claimed ("Recognizer program determines from the scout routine in client if the size of file ABCDE.DRV. stored by the client is the same as the size of file ABCDE.DRV. stored in the data base..." in col. 5 lines 13-16. The program on the client is automatically downloading update *information* from the server, as it is checking to see if the file stored locally is the same as the remote file on the server database.). However, as Cole does not explicitly disclose the limitations recited in the claim, the modification would at least be obvious in that Cole discloses that it was well known in the art at the time of the invention that downloading software update information comprises periodically automatically downloading software update information through the network to the computer (col. 1, lines 30-35, "whenever server obtains a new update,

server automatically sends update to client"). Cole states that, at times, a user may not want all available updates, however, in the occurrence that a user *would* want all of the available updates, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the downloading process completely automated in the system disclosed by Cole, as this would allow a user requiring all possible updates to install code fixes, new versions and revisions with little to no chance of human error.

As to claim 15, it would appear that Cole implies sending a software update query through the network requesting the software update information as claimed ("Recognizer program determines from the scout routine in client if the size of file ABCDE.DRV. stored by the client is the same as the size of file ABCDE.DRV. stored in the data base..." in col. 5 lines 13-16. As the program is requesting information from the database on the server, it is inherently making a software update query.). However, as Cole does not explicitly disclose the limitations recited in the claim, the modification would at least be obvious in that Cole further discloses that it was well known in the art at the time of the invention that downloading software update information includes sending a software update query through the network requesting the software update information (col. 1, lines 36-37, "client request all updates"). It would have been obvious to one of ordinary skill in the art at the time the invention was made to send a software update query requesting the software update information, as this would better inform the client as to what software updates are available for downloading and installation.

As to claim 16, the rejection of claim 15 is incorporated, and further, it would appear that Cole implies sending a software update query including software identification information identifying

software to be updated as claimed ("Recognizer program determines from the scout routine in client if the size of file ABCDE.DRV. stored by the client is the same as the size of file ABCDE.DRV. stored in the data base..." in col. 5 lines 13-16. As the program is requesting information from the database on the server, it is inherently making a software update query, and the query would include software identification information so that it can determine whether a different version exists.). However, as Cole does not explicitly disclose the limitations recited in the claim, the modification would at least be obvious in that Cole further teaches the software update query includes software identification information identifying software to be updated and the software update information relates to the software to be updated identified in the software identification information (col. 1, lines 36-37, shows "client identifying updates requested, and the server responds accordingly", col. 1, line 54, "identified code updates", lines 59-60, "server sends information about the list to the client"). One of ordinary skill in the art would be motivated to do this for the reasons set forth in connection with claim 15.

As to claim 21, rejection of claims 1, 2, 4, 5, 7, and 14 are incorporated and further claim 21 recites limitations as recited in claims 1, 2, 4, 5, 7, and 14, therefore, claim 21 is rejected under the same rationale as claims 1, 2, 4, 5, 7, and 14.

9. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole as applied to claim 8 above, and further in view of Fawcett (U.S. Patent No. 5,845,077), hereafter "Fawcett".

As to claim 9, Fawcett teaches the step of producing a notification that the software update has been installed (col. 10, lines 5-8, "log is created... software installed"). It would have been obvious to

one of ordinary skill in the art at the time of the invention to produce a notification that software is installed because it allows the user to determine available software on the computer and it is a well-known practice in the art to produce this notification.

As to claim 10, Cole further discloses the steps of determining if a computer reboot is necessary and including a request in the notification that the computer be rebooted if a computer reboot is necessary (col. 6, lines 52-55, "client is requested to reboot").

As to claim 11, Fawcett further discloses step of notifying the user of the availability of additional software updates (Abstract, "alert user to new products..."). It would have been obvious to include in the invention of Cole which indicates the code updates that are potentially appropriate for the client (col. 3, lines 65-67), an indication of the availability of new additional software updates, because the user will always have the most up-to-date computer software immediately available. Also, this inclusion offers a saving in advertising costs for the software developers.

10. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole as applied to claim 15 above, and further in view of Pedrizetti et al. (U.S. Patent No. 6,151,708), hereafter "Pedrizetti".

As to claims 17, Cole discloses a software update query but not a query for updates including software publisher information identifying a publisher of software to be updated and the software update information includes a list of software updates available for software published by the publisher identified in the software identification information. However, Pedrizetti teaches the

significance of a Dynamic Linked Library written by the vendor on the server computer associating a vendor to the updates to be downloaded by that particular vendor (col. 6, lines 1-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the query of Cole to request updates by a particular publisher because it would have facilitated in determining if the requested program updates are available from the particular server, and Pedrizetti's method allows for writing programs specifically tailored to a specific update.

As to claim 19, since claim 19 is an obvious variation over claim 17, rejection of Claim 17 is incorporated and further claim 19 recites limitations as recited in claim 17, therefore, claim 19 is rejected under the same rationale as claim 17.

11. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cole and Pedrizetti as applied to claim 17 above, and further in view of Fawcett.

As to claim 18, Fawcett further teaches the step of determining if a software update is available from the software update information comprises determining from the list of software updates if a software update is available for software on the computer (col. 6, lines 20-32, "summary contains information on software available...will be listed in summary").

Response to Arguments

12. Applicant's arguments filed 12 October 2004 have been fully considered but they are not persuasive.

Per claims 1-8, 12, 13, 20 and 22-26:

The applicant states that Cole fails to teach or suggest storing the user's preference and using the same to automatically download and install an update. In response, it is noted in col. 6 lines 23-30 discloses that a client makes a selection, and upon making that selection, the download routine downloads the software from the content server. Because the user makes a selection, and the download routine must be information of the user's selection, the user's preference of download choices is inherently stored, however temporarily, at some location, such that the download routine can access the user choices. From there, the download routine makes a determination whether any updates have been selected, based off the accessed stored user preference information, and automatically downloads the update, and then further, the server application routine automatically installs the update, as described in col. 6 lines 46-55. As such, Cole does disclose storing the user's preference and using the same to automatically download and install an update as claimed. Further, Cole also discloses a user criticality threshold, as the user would make a choice on what critical updates are required, and based on the threshold, represented by the user choices, updates would be downloaded and installed automatically. For these reasons, the rejections of claim 1-8, 12, 13, 20 and 22-26 are proper and maintained.

Per claims 14-16 and 21:

13. The applicant states that Cole teaches abandoning the prior art automated download and install process and require a manually initiated update and a manual selection of desired updates from a selection form. In response, note the rejections of the claims, wherein it is believed that Cole appears to imply the limitations required by claims 14-16 and 21. However, as Cole does not explicitly disclose the limitations required by the claims, the modification would at least be obvious

in that Cole also does not state that a fully automated download and install process is not possible in his invention; only that at times "the client may not need every code update..." Consequently, on the occasion that a client may need every code update, it would be obvious to one of ordinary skill in the art to fully automate the process, as stated in the rejections above. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As Cole indicates that fully automated downloading and installation systems are useful except in certain circumstances as when one would not require every update, no information was gleaned from the applicant's disclosure and as such, hindsight reasoning has not been used. For these reasons, the rejection of claims 14-16 and 21 is proper and maintained.

Per claims 17 and 19:

The applicant states that Pedrizetti does not teach that the software update query should identify one or more publisher/vendors. However, the applicant fails to supply a reason as to why the cited passage in the claim rejection above does not teach or suggest identifying one or more publisher/vendors. Furthermore, the applicant fails to show that the reasons to combine and motivations concerning the rejection of claim 17 and 19 are improper. As such, the rejection of claims 17 and 19 is proper and maintained.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trent J Roche whose telephone number is (571)272-3733. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571)272-3719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Trent J Roche
Examiner
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